

UNITED STATES PATENT AND TRADEMARK OFFICE

MAILED

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

APR 26 2006

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHRISTOF EBERSPACHER, MARTIN GAUSMANN, STEFAN GRAU,
TILMAN HAUG, PATRICK IZQUIERDO, HANSJORG ZELLER, JORG ZURN,
WOLFGANG REICHLE, and REINHARD ROSERT

Application No. 09/824,570

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received at the Board of Patent Appeals and Interferences on April 3, 2006. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing are identified below.

On December 8, 2005, appellants filed an Information Disclosure Statement (IDS). It is not clear from the record whether the examiner considered the IDS submitted or whether the examiner notified appellants of why the submission did not meet the criteria set forth in 37 CFR §§ 1.97 and 1.98.

Also, a review of the file indicates that the appeal brief filed June 30, 2005 does not fully comply with 37 CFR § 41.37(c).

37 CFR § 41.37(c) states in part:

(c)(1) The brief shall contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(I) through (c)(1)(x) of this section, except that a brief filed by an appellant who is not represented by a registered practitioner need only substantially comply with paragraphs (c)(1)(I) through (c)(1)(iv) and (c)(1)(vii) through (c)(1)(x) of this section:

(ix) *Evidence appendix.* An appendix containing copies of any evidence submitted pursuant to §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner. Reference to unentered evidence is not permitted in the brief. See § 41.33 for treatment of evidence submitted after appeal. This appendix may also include copies of the evidence relied upon by the examiner as to grounds of rejection to be reviewed on appeal.

(x) *Related proceedings appendix.* An appendix containing copies of decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c)(1)(ii) of this section.

A review of the application indicates that the following appropriate sections are missing from the appeal brief filed June 30, 2005:

- 1) "Evidence appendix" as set forth in 37 CFR § 41.37(c)(1)(ix); and

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2) "Related proceedings appendix" as set forth in 37 CFR § 41.37(c)(1)(x).

Furthermore, the examiner's answer mailed on August 29, 2005 does not comply with the headings as set forth in the new rules under 37 CFR § 41.37(c).

In addition, on page 3 of the answer, the examiner listed a new Ground of Rejection, as permitted by 37 CFR § 41.39(a)(2). However, according to the Manual of Patent Examining Procedures (MPEP) § 1207, the examiner's answer must include a subheading for the new Ground of Rejection. Correction is required.

For more information on the Board's new rules see the web page entitled More Information on the Rules of Practice Before the BPAI, Final Rule at:

<http://www.uspto.gov/web/offices/dcom/bpai/fr2004/moreinfo.html>

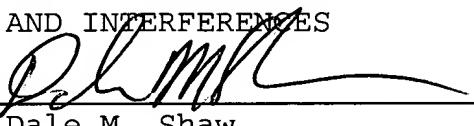
Accordingly, it is

ORDERED that this application be returned to the examiner to: 1) consider the Information Disclosure Statement filed December 8, 2005; 2) provide appropriate written notification by the examiner to appellants of such consideration 3) hold the appeal brief of June 30, 2005 defective; 4) request appellants to file a supplemental appeal brief in compliance with 37 CFR § 41.37 or to submit a statement from the examiner

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regarding the position taken on the missing appendices; 5) vacate the examiner's answer and provide a revised examiner's answer in accordance with the new rules effective September 13, 2004 and in response to the supplemental appeal brief; and 7) for such further action as may be appropriate.

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DMS/tdl